

MAR 27 2006

SNELL & WILMER

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT AND
THE WRITTEN OPINION OF THE INTERNATIONAL
SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

| | | |
|--|---|--|
| To: Howard I. SOBELMAN Snell & Wilmer L.L.P. One Arizona Center 400 East Van Buren Phoenix, Arizona 85004-2202 United States of America | | Date of mailing (day/month/year) 23 MAR 2006 |
| Applicant's or agent's file reference 70655.8616 | FOR FURTHER ACTION See paragraphs 1 and 4 below | |
| International application No. PCT/US05/30792 | International filing date (day month year) 29 August 2005 (29.08.2005) | |
| Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC. | | |

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

Filing of amendments and statement under Article 19:
 The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34 chemin des Colombettes
 1211 Geneva 20, Switzerland, Facsimile No.: +41 22 740 14 35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Reminders**

Shortly after the expiration of 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.

Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise, the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

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| Name and mailing address of the ISA/US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 Facsimile No. 571-273-3201 | Authorized officer: Blaine R. Copenheaver Telephone No. 571-272-7774 |
|---|--|

Form PCT/ISA/220 (January 2004)

(See notes on accompanying sheet)

Article 19 amend due 5-23-06

Disclose to USPTO

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

| | | |
|---|---|--|
| Applicant's or agent's file reference 70655.8616 | FOR FURTHER ACTION | see Form PCT/ISA/220 as well as, where applicable, item 5 below. |
| International application No. PCT/US05/30792 | International filing date (day/month/year) 29 August 2005 (29.08.2005) | (Earliest) Priority Date (day/month/year) 30 August 2004 (30.08.2004) |
| Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC. | | |

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the language, the international search was carried out on the basis of:

- ☒ the international application in the language in which it was filed
- ☐ a translation of the international application into _____, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))

b. ☐ With regard to any nucleotide and/or amino acid sequence disclosed in the international application, see Box No. I.

2. ☐ Certain claims were found unsearchable (see Box No. II)

3. ☐ Unity of invention is lacking (see Box No. III)

4. With regard to the title,

- ☒ the text is approved as submitted by the applicant
- ☐ the text has been established by this Authority to read as follows:

5. With regard to the abstract,

- ☐ the text is approved as submitted by the applicant
- ☒ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority

6. With regard to the drawings.

- a. the figure of the drawings to be published with the abstract is Figure No. 6
- ☒ as suggested by the applicant
- ☐ as selected by this Authority, because the applicant failed to suggest a figure
- ☐ as selected by this Authority, because this figure better characterizes the invention
- b. ☐ none of the figures is to be published with the abstract

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US05/30792

Box No. IV Text of the abstract (Continuation of item 5 of the first sheet)

The technical features mentioned in the abstract do not include a reference sign between parentheses (PCT Rule 8.1(d)). The abstract is too long (PCT Rule 8.1(b)). The abstract must be less than 150 words, or 200 words when no figure is to be published.

NEW ABSTRACT

A method and apparatus to facilitate giving a discount to a consumer subsequent to a point of sale purchase. A merchant (1350), manufacturer (106), and/or a consumer (1360) agree in advance with a financial account issuer (1355) to give a discount on qualifying purchases. The merchant (1350) and/or manufacturer (106) may access an intranet provided by the financial account issuer (1355) and input instructions related to one or more discount programs. The merchant (1350) requests payment authorization from the financial account issuer (1355) for the full (gross), agreed upon purchase price. If the purchase qualifies for a discount under one or more discount programs, the consumer's (1360) financial account (1365) is charged the full, agreed upon purchase price, and subsequently credited one or more discounts the transaction qualifies for without the consumer (1360) needing to perform a secondary task(s).

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US05/30792

A. CLASSIFICATION OF SUBJECT MATTER

IPC(8) - G06Q 40/00 (2006.01)

USPC - 705/39

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 705/14,16,20,24,30,34,35,39, 75 235/379,380

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
NONE

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

PUBWEST- PGPB, USPT, EPAP, and JPAB- searched Discount, rebate, consumer, customer, intranet, automatically, merchant, card member, automatic rebate, credit card, transaction, calculating, purchase price, secondary task, computer, american express.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category* | Citation of document, with indication, where appropriate, of the relevant passages | Relevant to claim No. |
|-----------|--|--------------------------------|
| X | US 6,105,001 A (MASI et al.) 15 August 2000 (15.08.2000), see col. 2 lines 37-48 and col. 3 lines 13-35. | 1,3,5,8,11, 20- 26,28,29,31 |
| A | US 6,014,635 A (HARRIS et al.) 11 January 2000 (11.01.2000), see the abstract and column 3-4. | 1-31 |
| A | US 6,249,772 B1 (WALKER et al.) 19 June 2001 (19.06.2001), see the entire document. | 1-31 |
| A | US 6,386,444 B1 (SULLIVAN) 14 May 2002 (14.05.2002), see the entire document. | 1-31 |
| A | US 6,748,365 B1 (QUINLAN et al.) 08 June 2004 (08.06.2004), see the entire document. | 1-31 |



Further documents are listed in the continuation of Box C.



See patent family annex.

* Special categories of cited documents:

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier application or patent but published on or after the international filing date

"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

"&" document member of the same patent family

Date of the actual completion of the international search

05 February 2006 (05.02.2006)

Date of mailing of the international search report

23 MAR 2006

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US, Commissioner for Patents
P.O. Box 1450, Alexandria, Virginia 22313-1450
Facsimile No. 571-273-3201

Authorized officer:

Blaine R. Copenheaver
Telephone No. 571-272-7774

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

| | | | |
|--|---|---|---|
| To: Howard I. SOBELMAN Snell & Wilmer L.L.P. One Arizona Center 400 East Van Buren Phoenix, Arizona 85004-2202 United States of America | | | Date of mailing <i>(day/month/year)</i> 23 MAR 2006 |
| Applicant's or agent's file reference 70655.8616 | | FOR FURTHER ACTION See paragraph 2 below | |
| International application No. PCT/US05/30792 | International filing date <i>(day month year)</i> 29 August 2005 (29.08.2005) | Priority date <i>(day month year)</i> 30 August 2004 (30.08.2004) | |
| International Patent Classification (IPC) or both national classification and IPC IPC(8) - G06Q 40/00 (2006.01) USPC - 705/39 | | | |
| Applicant AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC. | | | |

| |
|---|
| <p>1. This opinion contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p> |
| <p>2. FURTHER ACTION</p> <p>If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.</p> <p>If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.</p> <p>For further options, see Form PCT/ISA/220.</p> |
| <p>3. For further details, see notes to Form PCT/ISA/220.</p> |

| | | |
|---|--|--|
| Name and mailing address of the ISA/US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 Facsimile No. 571-273-3201 | Date of completion of this opinion 02 February 2006 (02.02.2006) | Authorized officer: Blaine R. Copenheaver Telephone No. 571-272-7774 |
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WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US05/30792

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of:



the international application in the language in which it was filed



a translation of the international application into _____, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material



a sequence listing



table(s) related to the sequence listing

b. format of material



on paper



in electronic form

c. time of filing/furnishing



contained in the international application as filed



filed together with the international application in electronic form



furnished subsequently to this Authority for the purposes of search

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US05/30792

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | | |
|-------------------------------|--------|----------------------------------|-----|
| Novelty (N) | Claims | <u>2,4,6,7,9,10,12-19,27,30</u> | YES |
| | Claims | <u>1,3,5,8,11,20-26,28,29,31</u> | NO |
| Inventive step (IS) | Claims | <u>2,4,6,7,9,10,12-19,27,30</u> | YES |
| | Claims | <u>1,3,5,8,11,20-26,28,29,31</u> | NO |
| Industrial applicability (IA) | Claims | <u>1-31</u> | YES |
| | Claims | <u>none</u> | NO |

2. Citations and explanations:

Claims 1,3,5,8,11,20-26,28,29, and 31 lack novelty under PCT Article 33(2) as being anticipated by Masi et al. (US 6,105,001 A) (hereinafter Masi).

As per claims 1, 20 and 21 Masi discloses receiving a request from a point of sale device, at a host computer, said request including instructions to charge a transaction amount from a financial account (Col. 2 Lines 37-48); charging said financial account, by said host computer, said transaction amount for a particular transaction; calculating said discount amount, by said host computer, for said particular transaction; (Col. 3 Lines 13-35) and, said crediting said financial account, by said host computer, said discount amount for said particular transaction, whereby said consumer does not perform a secondary task to receive said discount amount (Col. 3 Lines 13-35).

As per claim 3 Masi discloses the step of calculating said discount amount according to a discount program offered by an issuer of said financial account (Col. 3 Lines 13-35).

As per claim 5 Masi discloses matching an item identifier included in said request to a matched item in a list of items which qualify for said discount amount; and, calculating said discount amount according to a discount program associated with said item (Col. 3 Lines 13-35).

As per claim 8 Masi discloses calculating step comprises the step of calculating multiple discount amounts for said particular transaction (Col. 3 Lines 13-35).

As per claim 11 Masi discloses the step of determining if said request qualifies for a discount (Col. 3 Lines 13-35).

As per claim 22 Masi discloses receiving, at a host computer, information relating to a point of sale purchase of at least one item by a consumer from a merchant, wherein (Col. 2 Lines 37-48) said consumer purchases at least one item at a purchase price, said purchase price being agreed upon between said consumer and said merchant; and charging, by said host computer, a financial account associated with said consumer an amount less than said purchase price (Col. 3 Lines 13-35).

As per claim 23 Masi discloses operating said financial account by an entity other than said merchant (Col. 3 Lines 20-22).

As per claim 24 Masi discloses receiving a request from said merchant to charge said financial account an amount equal to said purchase price; determining that said purchase is a qualifying purchase; and, charging said financial account an amount less than said purchase price based upon discount rules associated with said qualifying purchase (Col. 3 Lines 13-35).

As per claim 25 Masi discloses receiving a request from said merchant to charge said financial account an amount equal to said purchase price; determining that said purchase is a qualifying purchase when said merchant previously agreed to discount said purchase price based upon discount rules associated with said qualifying purchase; and, charging said financial account in an amount less than said purchase price based upon discount rules associated with said qualifying purchase (Col. 3 Lines 13-35).

As per claim 26 Masi discloses receiving a request from said merchant to charge said financial account in an amount equal to said purchase price; determining that said purchase is a qualifying purchase when said merchant previously agreed to discount said purchase price based upon discount rules associated with said qualifying purchase, said discount rules including at least one of type of item, type of business of said merchant, type of said consumer, status of said consumer, behavior of said consumer and at least one of qualifying UPC and qualifying SKU; and, charging said financial account in an amount less than said purchase price based upon discount rules associated with said qualifying purchase (Col. 3 Lines 13-35).

As per claim 28 Masi discloses the computer-implemented method of claim 22 further comprising the step of issuing to said consumer a statement including information related to said amount less than said purchase price (Col. 3 Lines 13-35).

As per claim 29 Masi discloses receiving a request from said merchant to charge said financial account in an amount equal to said purchase price; determining that said purchase is a qualifying purchase when at least one of said merchant, said consumer, a manufacturer and a financial institution previously agreed to discount said purchase price based upon discount rules associated with said qualifying purchase; and, price based upon discount rules associated with said qualifying purchase (Col. 3 Lines 13-35).

See continuation in Supplemental Box below.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US05/30792

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of:

Continuation of Box 5

As per claim 31 Masi discloses debiting said financial account an amount less than said purchase price based upon discount rules associated with said purchase (Col. 3 Lines 13-35).

Claims 2,4,6,7,9,10,12-19,27,30 meet the criteria set out in PCT Article 33(2)-33(3), because the prior art does not teach or fairly suggest:

As per claim 2, the prior art does not disclose matching a merchant identifier included in said request to a matched merchant in a list of merchants offering said discount amount.

As per claim 4, the prior art does not disclose matching a manufacturer identifier included in said request to a matched manufacturer in a list of manufacturers offering said discount amount.

As per claim 6, the prior art does not disclose further comprising providing overlay promotions.

As per claim 7, the prior art does not disclose issuing a periodic statement associated with said financial account, wherein said periodic statement includes a listing of said discount amount for said particular transaction.

As per claims 9-10, the prior art does not disclose crediting step comprises crediting said financial account with a plurality of discount amounts for said particular transaction.

As per claims 12-13, the prior art does not disclose determining if said request qualifies for said discount amount when at least one of a merchant providing said request, an issuer is said financial account, an acquirer of said request, a manufacturer, a loyalty company, and a third-party merchant agrees to provide a discount to said consumer based upon at least one discount criterion.

As per claim 14, the prior art does not disclose the steps of: receiving and storing manufacturer item identifiers; receiving and processing a consumer ID; receiving and processing purchase data, wherein said purchase data comprises a retailer item identifier; associating said consumer ID, said purchase data, and a manufacturer item identifier; and determining said discount amount that is further dependent upon the step of associating said consumer ID, said purchase data, and said manufacturer item identifier.

As per claims 15-17, the prior art does not disclose the step of performing an analysis that is further dependent upon at least one of: a retailer ID, a manufacturer ID, and a consumer profile.

As per claim 18, the prior art does not disclose receiving and processing at least one of: a description of an item purchased, an item price, a number of items purchased, a total transaction amount, a payment vehicle, a date, a store identifier, and an employee identifier.

As per claims 19 and 27, the prior art does not disclose inputting one or more discount programs into a graphic user interface.

As per claim 30, the prior art does not disclose providing overlay promotions.

Claims 1-31 have industrial applicability as defined PCT Article 33(4) because the subject matter can be made or used by industry.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report and the written opinion of the International Searching Authority, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only (see *PCT Applicant's Guide*, Volume I/A, Annexes B1 and B2).

The attention of the applicant is drawn to the fact that amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established (see *PCT Applicant's Guide*, Volume I/A, paragraph 296).

What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.